

## REMARKS/ARGUMENTS

These remarks are responsive to the Office Action dated October 20, 2003. Claims 1-77 are pending in this application. Only claims 1, 34, 56, and 73 are independent. Claims 3, 4, 24, 25, 29, 30, 35, 47, 55, 58, 59, 68 and 77 are said to be allowable if rewritten to overcome the rejections under 35 U.S.C. 112 second paragraph and to include all of the limitations of the base claim and any intervening claims.

In the Office Action, dated October 20, 2003 the Examiner rejected claims 1, 2, 5-11, 16, 21-23, 31-34, 36-46, 50, 56, 57, 60-64, 66, 67, 71 and 73 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,252,588 to Dawson (“Dawson”). These rejections are respectfully traversed.

The Examiner also rejected claims 73 and 75 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,233,318 to Picard *et al.* (“Picard”). These rejections are respectfully traversed.

In the Office Action, dated October 20, 2003, the Examiner rejected claims 1, 2, 9-11, 13-15, 26, 28, 34, 48, 49, 56, 62-65, 69, 73 and 74 under 35 U.S.C. 103(a) as being unpatentable in view of U.S. Patent No. 5,568,540 to Greco *et al.* (“Greco”) in view of Dawson and in further view of U.S. Patent No. 5,778,054 to Kimura *et al.* (“Kimura”). These rejections are respectfully traversed.

The Examiner rejected claims 27 and 76 under 35 U.S.C. 103(a) as being unpatentable over Greco in view of Dawson and Kimura and further in view of Picard. This rejection is respectfully traversed.

The Examiner rejected claims 33 and 72 under 35 U.S.C. 103(a) as being unpatentable over Greco in view of Dawson and further in view of Kimura and further in view of U.S. Patent No. 5,651,054 to Dunn et al. ("Dunn"). These rejections are respectfully traversed.

Allowable Subject matter

Applicants would like to thank the Examiner for the indication that claims 3, 4, 24, 25, 29, 30, 35, 47, 55, 58, 59, 68 and 77 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112 second paragraph and to include all of the limitations of the base claim and any intervening claims. However, applicants are at a loss to find any 35 U.S.C. 112 second paragraph rejections in the October 20, 2003 office action. Additionally, for the reasons stated below, applicants respectfully assert that the base claims and any intervening claims are novel over the cited art and as such claims 3, 4, 24, 25, 29, 30, 35, 47, 55, 58, 59, 68 and 77 do not need to be rewritten.

35 U.S.C. 102(e)

The Examiner rejected claims 1, 2, 5-11, 16, 21-23, 31-34, 36-46, 50, 56, 57, 60-64, 66, 67, 71 and 73 under 35 U.S.C. 102(e) as being anticipated by Dawson. According to the Examiner, "Dawson teaches generating an information signal [senders thumbnail picture] relating a stored e-mail message to a senders [source] graphical image [thumbnail picture] and transmitting the information signal to a recipient's computer for indicating receipt of the stored e-mail message (Figure 10; column 9, lines 49-52; column 16, lines 56-67)." Applicants respectfully disagree with the examiner's interpretation of Dawson and with Examiner's interpretation of applicant's claim. First, Dawson does not generate an information signal relating a stored e-mail message to a sender's graphical image. Instead Dawson adds a thumbnail picture to the header of a message that is about to be sent (i.e. the message is not

stored). Therefore, Dawson does not disclose every element of the above listed claims and as such does not anticipate claims 1, 2, 5-11, 16, 21-23, 31-34, 36-46, 50, 56, 57, 60-64, 66, 67, 71 and 73. Additionally, the Examiner is respectfully confusing identifying a stored message with notification (indicating) that a message has been received. As the Examiner points out by his citation to Col. 9, lines 49-52, Dawson discloses a system that can be used to "identify" an email. Whereas the presently claimed invention claims methods and apparatuses which are used for notification that a message has been received. For this reason as well, Dawson does not disclose every element of the above listed claims and as such does not anticipate claims 1, 2, 5-11, 16, 21-23, 31-34, 36-46, 50, 56, 57, 60-64, 66, 67, 71 and 73. Second, with regard to the claim language, the claims are not limited to computers for receiving the information signal. Instead the claims use the terms communications device, which may include computers but may also include other types of devices.

Applicants respectfully request that the Examiner withdraw his rejections of claims 1, 2, 5-11, 16, 21-23, 31-34, 36-46, 50, 56, 57, 60-64, 66, 67, 71 and 73 as anticipated by Dawson.

In the October 20, 2003 Office Action, the Examiner rejected claim 73 under 35 U.S.C. 102(e) as being anticipated by Picard. This rejection is traversed.

The Examiner asserts that Picard teaches every element of claim 73. In support for this assertion, the Examiner cites to random unrelated sentences in Picard. Claim 73 of the present Application recites a method of indicating receipt of a stored message from a source, where the method includes the step of generating an information signal relating the stored message to at least one of: (i) a graphical image associated with the source; and (ii) a digital representation of a sound waveform associated with the source. The information signal is then transmitted to a

communication device that is associated with the addressee's device to indicate the receipt of the stored message.

While Picard discloses a multimedia mailbox that has a "notification mechanism," it does not disclose or suggest that such notification mechanism includes generating an information signal associated with the received stored message, where the information signal is either audio or video signal, and transmitting that information signal to a communications device associated with an addressee of the stored message as recited in claim 73. Accordingly, applicants respectfully request that the Examiner withdraw this rejection of Claim 73. Since Claim 75 depends from Claim 73, claim 75 is not anticipated by Picard for at least the same reasons stated above. Accordingly, applicants respectfully request that the Examiner withdraw this rejection of Claim 75.

35 U.S.C. 103(a)

In the Office Action, dated October 20, 2003, the Examiner rejected claims 1, 2, 9-11, 13-15, 26, 28, 34, 48, 49, 56, 62-65, 69, 73 and 74 under 35 U.S.C. 103(a) as being unpatentable over Greco *et al.* in view of Dawson and in further view of Kimura. These rejections are respectfully traversed.

The Examiner stated that Greco teaches every element of Claim 1 except including a graphical image in the information signal. The Examiner then cites to Dawson for the teaching of a digital image in the information message. Applicants respectfully point out to the Examiner, as stated above, that Dawson does not provide an information signal which relates a stored message to a graphical image. Instead Dawson provides a digital image in the header of the message that is being sent from the message originator to the message recipient. The digital image that is being transmitted (i) is not in an information signal and (ii) is not related to a stored

message when it is being transmitted. As such, Dawson does not cure the deficiencies of Greco and could not be used to cure the deficiencies of Greco without using improper hindsight. Kimura also does not cure the deficiencies of Greco as Kimura also does not teach or suggest an information signal which relates a stored message to a graphical image. For at least the foregoing reasons, claims 1, 2, 9-11, 13-15, 26, 28, 34, 48, 49, 56, 62-65, 69, 73 and 74 are not rendered obvious by the combination of Greco, Dawson and Kimura and applicants respectfully request that the Examiner withdraw his rejections thereto.

The Examiner rejected Claims 27 and 76 under 35 U.S.C. 103(a) as being unpatentable over Greco in view of Dawson, further in view of Kimura and further in view of Picard. These rejections are traversed.

Claims 27 and 76 depend from Claims 1 and 73 respectively. For the reasons stated above, neither claim 1 nor claim 73 is rendered obvious by the combination of Greco, Dawson and Kimura. Picard does not cure the deficiency of this combination since Picard also does not teach or suggest an information signal which relates a stored message to a graphical image. As such, since the base claims from which these two claims depend are both novel over the asserted combination, Claims 27 and 76 are novel for at least the same reasons. As such, applicants respectfully request that the Examiner withdraw the rejections of Claims 27 and 76.

The Examiner rejected Claims 33 and 72 under 35 U.S.C. 103(a) as being unpatentable over Greco in view of Dawson, further in view of Kimura and further in view of Dunn. These rejections are respectfully traversed.

Claims 33 and 72 depend from Claims 1 and 56 respectively. For the reasons stated above, neither claim 1 nor claim 56 is rendered obvious by the combination of Greco, Dawson and Kimura. Dunn does not cure the deficiency of this combination since Dunn also does not

teach or suggest an information signal which relates a stored message to a graphical image. As such, since the base claims from which these two claims depend are both novel over the asserted combination, Claims 33 and 72 are novel for at least the same reasons. As such, applicants respectfully request that the Examiner withdraw the rejections of Claims 33 and 72.

No new matter has been added.

The claims currently presented are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to the Applicants' undersigned attorney to expedite further processing of the application to allowance.

Respectfully submitted,

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Richard M. Lehrer  
Richard M. Lehrer  
Reg. No.: 38,536  
MINTZ LEVIN COHN FERRIS  
GLOVSKY AND POPEO PC  
Chrysler Center  
666 Third Avenue  
New York, NY 10017  
212-935-3000